

Serial No. 10/084,379
Amendment
Responsive to Office Action dated October 17, 2008

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REMARKS

Pending Claims

Claims 76-91 are pending in this application. Claims 1-6, 8-25, 29 and 40-75 have been canceled without prejudice or disclaimer. New claims 76 - 91 have been added. No new matter has been added.

Claim Rejections under 35 U.S.C. §103

Claims 1-6, 8-10, 12-25, 29, and 40-75 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ueki et al, U.S. Patent No. 6,678,236, in view of Maeda et al, U.S. Patent No. 6,654,547.

Claim 11 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ueki et al, '236, in view of Maeda et al '547, and further in view of Nishio, U.S. Patent No. 5,887,192.

Applicants have canceled claims 1-6, 8-25, 29 and 40-75 without prejudice or disclaimer. In place of the canceled claims, applicants submit new claims 76-91, which include new independent claims 76, 86 and 88.

New claims 76-91 are not taught or suggested by Ueki, Maeda or Nishio, whether considered individually or in combination. Accordingly, the rejections under 35 U.S.C. §103(a) are traversed for the following reasons.

Claims 76-91 clearly describe the features of the present invention. In particular, independent claims 76, 86 and 88 set forth a method of recording information and a recording medium in which the recording medium includes a user data area in which user data can be

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erased or recorded, and a management area in which management information is recorded. For example, see Figure 4 which shows a physical user area having recording-limited portions. The recording-limited area of independent claims 76, 86 and 88 is further set forth as being an area in which recording is physically possible but is logically limited. See page 4, lines 1-6 of the specification describing the recording-limited area:

The recording-limited area can be created by making it impossible to read the allocation information for the limited area. This limit can be canceled by recording the allocation information for the limited area on the recording medium. Since a recording cannot be performed without the allocation information for the recording limited area, the recording medium cannot be recorded at this stage.

According to claims 76 and 88, the recording limit is canceled by playing back or reading predetermined information that is pre-recorded in the recording-limited area. The canceling of the recording limit, according to an exemplary embodiment of the present invention, is understood first from the explanation of the manner in which the recording limit is set. See the specification, page 4, lines 14-25:

The recording-limited area can be created in the following manner. In a DVD-RAM, a physical ID (address information) is allocated in the form of an embossed pit at the head of each recording sector, as shown in FIG. 6. To ensure reliability, the address information for identifying a single sector is recorded quadruply. The recording apparatus determines that the address is correct if any one of the four pieces of address information can be correctly played back. Therefore, to make a recording impossible, all the four pieces of address information are rendered incapable of correctly being played back. An example of the method of rendering the address incapable of normal playback can be explained by referring to FIG. 8, showing the address information consisting of a sector attribute, an address number, and an IED (ID error detection code). In this method, the IED added to each address information is made inconsistent to the corresponding ID.

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Second, the recording limit is canceled in the following manner according to page 4, lines 26-35 of the specification:

On the other hand, in a step of canceling the limit, the specialized control software is used to perform processes such as a defect-sector jump processing or a replacement processing based on the recording limited area allocation information in the information recording medium, thereby re-writing a defect management table. In the case of making the ID error detection code (IED) added to each address information inconsistent with the corresponding ID, as mentioned above, specifically the inconsistency was introduced by adding one to the otherwise-consistent IED. To eliminate this inconsistency, one was subtracted from the IED, thereby obtaining the original, consistent IED and canceling the limit by which the recording was made impossible.

According to the specification, in order to make the recording limited area in which recording is logically limited, all four pieces of address information are rendered incapable of being played back normally. This is accomplished by rendering the normal playback of the address impossible, i.e. the ID error detection code (IED) which is added to each address information was made inconsistent with a corresponding ID by adding one to the originally consistent IED. Rendering the ID data itself inconsistent is preferable since it can be accomplished during the mastering of the media and can be automatically applied to all the media at the same time that the substrate is formed, which helps to prevent cost increases. See page 14, lines 8-12 of the specification. Numerous other examples are provided in the specification for making the recording limited area and for canceling the recording limit. For example, according to another embodiment of the invention, instead of rendering all the IDs in the recording-limited area incapable of being played back, at least the initial two sectors and

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the last three sectors in each track were made capable of playback. *See* the second embodiment discussed in the specification beginning on page 13.

According to independent claims 76 and 86, new user data or new information is recorded in the recording-limited area for which the recording limit has been canceled. the limited area can be canceled and a readout made possible by utilizing a specialized control software. This specialized control software instructs the display of the target information (such as an advertisement) and thereafter cancels the recording limit. *See* page 4, last line to page 5, line 2 of the specification, for example. Further, after the recording limit is canceled so that a recording can be performed in, for example, the recording-limited area. *See* page 9, lines 1-5 of the specification, which also mentions that the displayed target information may be an advertisement.

Claims 77 and 89 set forth that the recording limit is provided by rendering a read-out of allocation information for the recording-limited area impossible. Further, claim 77 states that the step of canceling the recording limit records the allocation information for the recording-limited area in the recording medium. *See* page 4, lines 1-3 of the specification, for example.

Claim 78 sets forth that the recording limit is provided by rendering a read-out of allocation information for the recording-limited area impossible, and the step of canceling the recording limit records allocation information for the recording-limited area on software. *See* page 4, lines 11-12 of the specification, for example.

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Claim 79 sets forth that an instruction is issued to record information to the recording medium prior to the canceling of the recording limit, and an instruction is issued to display predetermined information in response to the recording instruction being issued. *See* page 5, lines 27-30 of the specification, for example.

Claims 80 and 91, which set forth that the pre-recorded information is an advertisement, are supported by the specification. *See* page 9, lines 1-5 of the specification, which mentions that the displayed target information may be an advertisement.

Claim 81, which sets forth that the predetermined information is recorded in the recording medium and claim 82 sets forth that the predetermined information is recorded in software. Further, claim 83 sets forth that the predetermined information is displayed via an external information distribution means. For support in the specification of these claims, Applicants refer to page 17, lines 28-36 of the specification, and Figs. 13-15, for example.

Claim 84, which sets forth that the recording limit limits recording by rendering an ID error detection code of address information for the recording-limited area inconsistent with an ID corresponding to the ID error detection code, and the canceling of the recording limit is performed by rendering the ID error detection code thus made inconsistent, to be consistent with the ID, is discussed in the specification on page 4, as mentioned above. *See*, for example, page 4, lines 26-35 of the specification.

Regarding claim 85, *see* page 11, lines 17-23 of the specification which provides support for the allocation information being erased by erasing the predetermined information.

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Claim 86 sets forth that the position of the recording-limited area is recorded in the user data area in an encrypted form. In the claimed method, the information about the position that is in encrypted form is decrypted by predetermined software and new information is recorded in the recording-limited area for which the recording limit has been canceled. *See* Embodiment 3 of the application and page 18, lines 23-33 of the specification which support the limitations of independent claim 86. Also, support is provided for claim 87, which sets forth that the recording-limited area can be allocated in a distributed manner in a user area of the recording medium. *See* page 18, lines 11-13 of the specification.

Regarding support for claim 90, which states that the predetermined information and said allocation information are recorded at the same time, Applicants refer to page 14, lines 8-12 of the specification, for example.

Thus, as is clear from the above, the references of record to not show or suggest the main features of the present invention including providing a user data area including a recording-limited area in which predetermined information is pre-recorded and in which recording is physically possible, but is logically limited, in combination with canceling the recording limit in response to playing back or reading predetermined information, as set forth in claims 76 and 88. Further, the references of record to not show or suggest the feature of the invention set forth in claim 86 in which the information about the position of the recording-limited area is recorded in the user area in encrypted form and is decrypted by predetermined software, followed by recording new information in the recording-limited area for which a recording limit has been canceled.

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Ueki is concerned with protecting a DVD-Video from illegal copying. The copyright information is designed to prevent the contents of the main information recorded on the disc from being illegally copied. The copyright information is recorded in an area of the disc which is assigned to information related to copyright protection such as information of a CSS key (a contents scramble system). When there is incompatibility between the CSS key that is read out and the correct CSS key, then the reproduction by the DVD-Video player is suspended. When the information of the CSS key is correct, the player is permitted to reproduce the contents or main information from the disc. *See*, col. 1, lines 31-38 of Ueki.

Ueki is replied upon in the Office Action for disclosing a lead in area (LI) formed by a pre-pit area PR that is asserted to be equivalent to the recording-limited area set forth in the claimed invention. The rejection is further based on the interpretation that the information recorded as the lead-in information (pre-pits) could be any type of information, such as the predetermined (advertisement) information of the invention. Applicants respectfully request reconsideration of the interpretation given to Ueki in view of its application to the pending claims.

The claimed recording-limited area of the independent claims is an area of the user data area in which recording is physically possible but is logically limited. The Copyright protection information (CSS key) of Ueki, on the other hand, is recorded in the lead-in areas which are composed of lead-in areas LI1 and LI2. Specifically, the Copyright protection information is recorded in the second lead-in area LI2.

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By comparison, in the present invention, the recording limited area is in the user data area. Further, it is claimed that new information is recorded in the recording limited area, according to independent claims 76 and 86. Ueki discloses that "the copyright-protection-related information cannot be altered by an error correction process." See col. 9, lines 44-53 of Ueki. The second lead-in area LI2 is represented by pits (pre-pits) in the disc (col. 10, lines 2-6 of the reference), and the pre-pits represent the copyright-protection-related information (col. 10, lines 21-23 of Ueki).

Thus, the comparison of Ueki's copyright-protection-related information to the pre-recorded, predetermined information that is recorded in the recording limited area, as set forth in claim 76, fails since the Ueki's recording area is a lead in area LI2, not a user area, and there is no suggestion to record new information in the lead in area of Ueki. Rather, one of ordinary skill in the art would realize that new information would not be recorded in the copy protection information area of Ueki since this would invalidate the copyright protection provided by the information that is recorded in the copy protection information area.

According to Ueki, it is an object of the invention to maintain an unaltered state of the copyright-protection-related information since the information is used to determine whether playback of contents data should be permitted. In the description of Fig. 14, Ueki states that "[t]he step S19 may stop the reproduction of the contents information when the reproduced lead-in information and the apparatus are in a predetermined unacceptable relation." See col. 26, lines 12-15; and col. 27, lines 14-17. Accordingly, there is no disclosure or suggestion by Ueki to record information in the lead in area.

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The lead in area of Ueki, in which the copyright-protection-related information is recorded, is also not comparable to the recording limited area of the claimed invention because the recording limit of the lead in area is not cancelled. The Office Action cites Ueki for disclosing a recording operation (Fig. 15) that suspends recording at the timing corresponding to the starting edge of the pre-pit area PR by changing the operation of the apparatus from the recording mode to the playback mode. According to the reference, the recording continues to be suspended until the timing corresponding to the ending edge of the pre-pit area PR and given by the LPP-based recording timing signal. *See*, col. 26, 51-58 of Ueki.

However, the recording operation of Ueki, which includes switching to playback when the pre-pit area PR is encountered, and then resuming recording after the pre-pit area PR has been passed, is not equivalent to the claimed canceling of the recording limit for a recording-limited area in the user data area, as in the claimed invention. The "recording limit" of Ueki, i.e. the state in which the lead in area has predetermined information (copyright information) that is pre-recorded and in which recording is physically possible but is logically limited, for example in the pre-pit area, is unchanged by the recording process described with respect to Fig. 15 in Ueki. The switching to the playback mode in the pre-pit area is merely designed to prevent the data in the pre-pit area from being overwritten. *See*, col. 26, lines 57-63 of Ueki. On the other hand, when the recording limit of a recording limited area is cancelled according to the claimed invention, new information is recorded in the recording limited area (independent claims 76 and 86). Further, the recording limit is canceled by playing back or

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reading predetermined information that is pre-recorded in the recording-limited area (independent claims 76 and 88).

According to the present application, the recording medium is rewritable which allows for erasure and re-recording of user data in the user data area where the target information such as an ad is recorded, and further erasure or re-recording in the recording limited area is physically possible but is logically limited until the predetermined information, such as an ad is displayed and recording limit canceled. Thus, the present invention provides a recording-limited area in which recording is limited so that a manufacturer or user can record desired information and expect that the desired information will be displayed to the user. Further, the recording limit can be canceled, preferably after the reading or playing back of the desired information. See Fig. 11, page 17, lines 8-20 and page 6, lines 22-31 of the specification, for example. These achievements are not attainable by Ueki or suggested by Ueki to one having ordinary skill in the art.

Maeda is relied upon for disclosing a method/system that teaches the display of an advertisement, such as a commercial message (CM). However, Maeda does not disclose or suggest a recording-limited area in which predetermined information is pre-recorded and in which recording is physically possible but is logically limited, and in which recording of information in the recording-limited area is performed after the canceling of the recording limit, as claimed in independent claims 76 and 86.

Nishio is relied upon for disclosing the combination of movie data and advertisement data, however the reference also does not make up for the deficiencies in Ueki and Maeda.

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Each of the dependent claims are patentable at least for depending from a base claim asserted to be patentable for the foregoing reasons. Accordingly, none of Ueki, Maeda or Nishio, whether considered in combination or individually, renders the invention as set forth in claims 76-91 unpatentable under 35 U.S.C. §103. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejections.

None of Maeda, Ueki, or Nishio, whether considered individually or in combination, discloses the features of the invention as set forth in the independent claims. The dependent claims set forth additional limitations that are not shown or described in the art of record. Further, each of the dependent claims is allowable at least for depending from a base claim asserted to be patentable for the foregoing reasons. Accordingly, none of Ueki, Maeda or Nishio, whether considered in combination or individually, renders the invention as set forth in claims 76-91 unpatentable under 35 U.S.C. §103, and therefore Applicants respectfully request withdrawal of the rejections.

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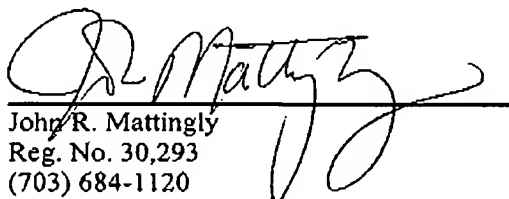
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Conclusion

In view of the foregoing, Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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